

REMARKS

Claims 1-21 are in the case and presented for consideration.

Claims 1-21 were rejected under 35 U.S.C. 103(a) as being obvious from U.S. Published Patent Application 2002/0186412 to Murashita in view of U.S. Patent 6,088,594 to Kingdon.

A PRIMA FACIE CASE HAS NOT BEEN ESTABLISHED

Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. *MPEP §2142; In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992). Only when *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. *MPEP §2142; In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP §2142 ; In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

Independent claim 1 recites:

linking the mobile phone position information to said position specific multimedia content at a WAP portal (emphasis added)

None of the cited references teach or suggest this limitation. The Office cites "fig. 4-6, mobile station 30A, camera 10A, paragraph 0056, and 0112-0113." Fig. 4-6 do not identify linking mobile phone position information to position specific multimedia content. Nor do Figs. 4-6 show a WAP portal. The relevance of the identified items 30A and 10A is unclear. The Office should conduct an element-to-element comparison of the claimed elements and the identified items 30A and 10A to identify which claimed element 10A represents and which claimed element 30A represents. Nevertheless, no WAP portal is identified in conjunction with these items. The apparently relevant portion of paragraph 0056 explains that:

Further, since the mobile terminal may have a means for obtaining its current position and also a means for transmitting this current position, it is possible for the mobile terminal to notify a position information obtaining means of the terminal's current position as position information representing a place where image data has been obtained.

No WAP portal is mentioned in the cited paragraph.

With respect to paragraphs 0012-0113, Murashita discloses that a header of image data is input from the camera 10A to image data storage device 20A [0112]

and that the position information received by receiver 22A of image data storage device 20A is written in the header of the image data received from digital camera 10A [0113-0114]. The linking is done in the header stored in the image data storing unit 21A [0114]. Paragraph 94 describes storage device 20A/image data storing unit 21A as follows:

Image data storage device 20A, which is connected with digital camera 10A via a cable supporting USB (Universal Serial Bus) so as to store image data obtained by digital camera 10A, is carried by a photographer (user) together with digital camera 10A. In use, image data storage device 20A can be provided in the form of a hard disc unit, for example...

Thus, the linking is done on a portable hard disc, or the like. As a result, the Office's position is not logical. A hard drive cannot be logically construed as a WAP portal.

Claim 11 recites limitations substantially similar to the limitations recited in claim 1.

Thus, claims 1 and 11, and all claims depending therefrom are believed to be patentable.

Applicants respectfully remind the Examiner that it is the duty of the Examiner to specifically point out each and every limitation of a claim begin rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly

explained and each rejected claim specified.” Referring vaguely to drawings and columns and lines without any explanation, does not satisfy 37 C.F.R. §1.104(c)(2).

Furthermore, MPEP section 706 states that “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” The present Office Action entirely fails to meet this goal for the following reasons.

Applicants previously indicated in the last response that Murashita ‘412 does not teach or suggest linking “at a WAP portable”. Applicant explained in great detail that Murashita ‘412 only teaches linking at the image data storing unit 21A, and that linking is not done at a WAP portal. In response, the Office indicates “Applicant’s arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.” The Office then proceeds to reject the claims, indicating that Murashita ‘412 discloses “linking...at a WAP portal”. The Office repeats the same references to drawings and lines as in the previous rejection, without providing any new indication of what is considered to be a WAP portal in the cited reference. The Office does not respond at all to Applicant’s arguments. Applicant respectfully submits that the present Office Action improperly sidesteps and ignores Applicant’s previously submitted arguments with respect to patentability. The addition of a new reference had no effect at all on the limitation at issue (i.e., the new reference is not cited as teaching linking...at a WAP portal), and the Office should have responded since Applicant’s arguments still apply.

By making this action final without responding to the Applicant's previous argument and clearly articulating the rejection early in the prosecution process per MPEP 706, the Applicant has not had the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. As a result, Applicant is unduly prejudiced by the Office's lack of response. Additionally, the Office's failure to identify specifically which features of the cited reference(s) are deemed to correspond to the claimed elements is also a failure to clearly articulate the rejection early in the prosecution process, and does not satisfy the requirements under 37 C.F.R. §1.104(c)(2), as described above.

Turning now to claim 19, claim 19 recites:

communication means for communicating between said
mobile phone and said multimedia device

The Office first refers to Murashita as disclosing multimedia content recorded by a multimedia device. It is believed that the Office refers in particular to camera 10A as the claimed "multimedia device" and camera-captured images as "multimedia content recorded by a multimedia device." The term "multimedia device" in the body of the claim is derived by antecedent basis from the preamble usage of "multimedia device". Under this construction, the Office must show communication means for communicating between a mobile phone and the camera 10A. Instead, the Office now cites Kingdon '594 for what appears to be the disclosure of a Mobile Station (MS) (i.e., portable phone) communicating with an Mobile Positioning

Center (MPC). It appears that the Office construes the MPC as Applicant's claimed multimedia device.

First, the Office does not provide any basis for making such a construction, and again fails to satisfy 37 C.F.R. §1.104(c)(2) and MPEP section 706. Second, the Office's identification of the MPC as a "multimedia device" from the body of claim 19 is entirely inconsistent with its earlier identification of the camera 10A as a "multimedia device" in the preamble. Second, even if assuming *arguendo* that the MPC was construed as a "multimedia device," the Office has not shown that position specific multimedia content is recorded by the MPC and that mobile phone position information is linked to the position specific multimedia content recorded by the MPC.

Furthermore, claim 20 similarly recites:

linking the mobile phone position information to said position specific multimedia content based on communication between said mobile phone and said multimedia device.

The claimed mobile phone position information in this limitation was obtained in the earlier recited step, which the Office deemed to be taught by Kingdon '594. Thus, the Office must show prior art disclosing that after the mobile phone position information is obtained by means described in Kingdon '594, the obtained mobile phone position information is linked to position specific multimedia content based on communication between the mobile phone and the multimedia device. The Office claims that Murashita makes such a showing, without any detailed

explanation of which features in Murashita correspond to the claimed elements. In fact, the Office fails to make such a showing. Applicants previously submitted in the last response that devices 30A (e.g., mobile telephone) and 10A (e.g., camera) do not communicate with each other. The Office has not responded. The Office's failure to respond to Applicant's arguments in any understandable or clear manner is a failure to satisfy the requirements under MPEP 706 and under 37 C.F.R. §1.104(c)(2).

Notably, in the rejection of claim 19, the Office states that "Marushita fails to specifically disclose...communication means for communicating between said mobile phone and said multimedia device". However, in the rejection of claim 21, the Office states that "Murashita teaches...communication between said mobile phone and said multimedia device". The Office's own position is inconsistent between rejected claims having substantially similar limitations regarding communication between said mobile phone and said multimedia device.

Claim 20 depends from claim 19 and is believed to be patentable for at least the same reasons described above.

Applicant stresses that the Office's failure to explain how the rejected claims are obvious by pointing out where *all* of the specific limitations recited in the rejected claims are found in the cited reference has consistently resulted in reversal of a final rejection by the Board of Patent Appeals and Interferences. See for example, *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

The Commissioner is hereby authorized to credit any overpayment or charge any fee (except the issue fee) to Account No. 14-1270.

Respectfully submitted,

/Yan Glickberg/

Yan Glickberg
Reg. No. 51,742
Tel: (914) 333-9618